

This Opinion is not a
Precedent of the TTAB

Oral Hearing: May 29, 2018

Mailed: June 20, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Night Wines, LLC

Serial No. 87084959

Lawrence Papale of Law Offices of Lawrence G. Papale,
for Night Wines, LLC.

Esther Queen, Trademark Examining Attorney, Law Office 111,
Robert L. Lorenzo, Managing Attorney.

Before Rogers, Chief Administrative Trademark Judge,
Mermelstein, and Wellington, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Night Wines, LLC (Applicant) seeks registration on the Principal Register of the standard character mark NIGHT for “wine” in International Class 33.¹

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that there is a likelihood of

¹ Application Serial No. 87084959, filed on June 27, 2016. The application was filed under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intent to use the mark in commerce.

confusion among consumers because Applicant's mark is the English translation of the registered standard character mark, NOCHE, and both marks are for wine.²

After the Examining Attorney made the refusal final, Applicant filed concurrently a request for reconsideration and an appeal.³ The Examining Attorney denied the request for reconsideration and the appeal proceeded.⁴ The appeal has been briefed and an oral hearing was held on May 29, 2018. We affirm the refusal to register.

I. Preliminary Evidentiary Matters

In its request for reconsideration, Applicant referenced various third-party registrations and included a list of pairs of registrations.⁵ In denying the request for reconsideration, the Examining Attorney informed Applicant that "the mere submission of a list of registrations or a copy of a private company search report does not make such registrations part of the record" and "to make third party registrations part of the record, an applicant must submit copies of the registrations, or the complete electronic equivalent from the USPTO's automated systems, prior to appeal," citing to TRADEMARK BOARD MANUAL OF PROCEDURE (TBMP) § 1208.02 (June 2017).⁶

² Registration No. 3546006 issued on December 16, 2008; Section 8 affidavit accepted and Section 15 declaration acknowledged.

³ 1 TTABVUE (appeal) and 4 TTABVUE (request for reconsideration).

⁴ 5 TTABVUE (Office action denying request for reconsideration).

⁵ 4 TTABVUE 8-10.

⁶ 5 TTABVUE 3.

In its appeal brief, Applicant again made mention of the third-party registrations and provided the same list.⁷ The Examining Attorney, in her brief, “objects to the list of third-party registrations referenced by applicant with its appeal brief,” as improperly of record since copies of the registrations were not filed.⁸ In its reply brief, Applicant requests that the Board take judicial notice of the third-party registrations and/or “leave of court to supplement the record to include the referenced third-party registrations.”⁹

Trademark Rule 2.142(d) makes it clear that the record in the application should be complete prior to the filing of an appeal. *See* TBMP § 1207.01. As the Examining Attorney informed Applicant, TBMP § 1208.02 provides, in relevant part, that the “mere listings of registrations, or copies of private company search reports, are not sufficient to make the registrations of record.” TBMP § 1208.04 further instructs that “[t]he Board’s well-established practice is not to take judicial notice of third-party registrations when an applicant or examining attorney requests that such notice be taken during the course of an appeal.” To the extent that Applicant’s request for “leave of court to supplement the record” can be considered a motion for remand, albeit untimely, Applicant has not shown good cause and as such a request it is therefore denied. *See In re Adlon Brand GmbH & Co.*, 120 USPQ2d 1717, 1725 (TTAB 2016) (applicant’s request for remand, included in applicant’s brief, denied,

⁷ 7 TTABVUE 8-10.

⁸ 9 TTABVUE 3.

⁹ 10 TTABVUE 3.

explaining that proper procedure “was to file with the Board, after the filing of the appeal but before briefing, a request for remand with a showing of good cause.”); *In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1147 (TTAB 2011) (applicant’s request for remand denied for failure to show good cause).

Accordingly, the Examining Attorney’s objection is sustained and the third-party registrations mentioned in Applicant’s brief, including the list, are not considered.¹⁰

We further note that Applicant, in its request for reconsideration and in its appeal brief, makes reference to and provides a list of purported Certificates of Label Approval (“COLAs”) issued for wine by the Alcohol and Tobacco Tax and Trade Bureau [TTB].¹¹ Applicant argues that the COLAs “demonstrate[] that the actual use of the word NIGHT within the term MIDNIGHT for wine in the marketplace is not unique; in fact, it is rather commonplace.”¹² Applicant did not submit copies of the COLAs, but even if it had, a COLA is only evidence that the label at issue was *approved* by the TTB for use on alcoholic beverages. It is not evidence that the label in question was or is in *use* in commerce, let alone the extent of any such use. *Cf. AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) (“existence of [third-party] registrations is not evidence of what happens in the market place or that customers are familiar with them.”). Nevertheless, inasmuch as

¹⁰ We note that the Examining Attorney cited in the first Office action an additional registered mark as a bar to registration. Registration No. 3994332 (NIGHT for “beer”) was cited and a copy of the registration was submitted. Although this registration was later withdrawn as a basis for refusal, it is of record for whatever probative value it may have.

¹¹ 7 TTABVUE 11-12 and 14-16.

¹² *Id.* at 14-15.

the Examining Attorney has not objected, we have considered the list of COLAs submitted by Applicant. However, as explained, the probative value of this list is severely limited and, contrary to Applicant's contention, the COLAs do not demonstrate use in commerce of any brand name on a TTB-approved label.

II. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

1. Identity of the Goods, Their Trade Channels and Consumers

We first consider the *du Pont* factors addressing the similarity of the goods, the channels of trade in which they may be encountered and the purchasers to whom they are marketed. Here, the goods are identical – Applicant seeks registration of its mark for “wine” and the cited registration covers “wine.” Because Applicant's and Registrant's goods are identical, we must presume that the channels of trade and classes of customers for the wine are the same. *See Am. Lebanese Syrian Associated*

Charities Inc. v. Child Health Research Inst., 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012).

Accordingly, we find that the *du Pont* factors relating to the similarity of the goods, the trade channels through which they travel, and the customers to whom they are offered, all favor a finding of likelihood of confusion.

2. Similarity of the Marks

We consider next the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). “The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)) (internal quotation marks omitted).

At the outset, we note that NIGHT and NOCHE both begin with the same letter and are five-letter terms with the fourth letter also being H; however, the similarity

in appearance ends there. As to sound, aside from both marks beginning with the letter N, there is no reason to believe the marks will sound alike when spoken.¹³

As to connotation and commercial impression, the Examining asserts that the “doctrine of foreign equivalents” is applicable in this case in that the registered mark, NOCHE, is in a common, modern foreign language (Spanish) and that Applicant’s mark, NIGHT, is the English equivalent. Specifically, she relies on the evidence of record showing the Spanish term “noche” directly translates to the English word “night,” and therefore the marks are very similar in connotation.¹⁴

Applicant acknowledges that “noche” is the Spanish word for “night,” but argues that “registration should not be refused to NIGHT based solely on its translation to ‘NOCHE’ in Spanish, given the other differences between the marks in sound and appearance.”¹⁵ Applicant asserts that the doctrine of foreign equivalents is limited to meaning only and, in this case, does not result in a finding that the marks are confusingly similar.¹⁶

Whether the doctrine of foreign equivalents is relevant turns upon the significance of the foreign mark to the relevant purchasers, which is based on an analysis of the evidence of record. The doctrine may be applied to words or terms from common, modern languages. *Palm Bay Imps. Inc.*, 73 USPQ2d at 1696. Although words from

¹³ Applicant argues that “the registered mark consists of two syllables with the emphasis on the first syllable, i.e., NO-chey.” 4 TTABVUE 6.

¹⁴ 9 TTABVUE 7; the dictionary and translation evidence cited by the Examining Attorney was attached to the Office Action issued on April 25, 2017, TSDR pp. 2-7.

¹⁵ 7 TTABVUE 7.

¹⁶ *Id.*, citing “*McCarthy [on Trademarks and Unfair Competition]* at §23.14.”

modern languages are generally translated into English, the doctrine of foreign equivalents has evolved into a guideline, not an absolute rule, and is applied only when it is likely that “the ordinary American purchaser would ‘stop and translate’ [the term] into its English equivalent.” *Id.*, (quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976)). *See generally* TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 1209.03(g) (Oct. 2017). However, “[w]hen it is unlikely that an American buyer will translate the foreign mark and will take it as it is, then the doctrine of foreign equivalents will not be applied.” *Palm Bay Imps. Inc.*, 73 USPQ2d at 1696, (citing *In re Tia Maria, Inc.*, 188 USPQ 524 (TTAB 1975) (no likelihood of confusion between TIA MARIA for a Mexican restaurant and AUNT MARY’S for canned vegetables)). The “ordinary American purchaser” includes “all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English.” *In re Spirits Int’l, N.V.*, 563 F.3d 1347, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009).

In this case, we agree with the Examining Attorney that the doctrine of foreign equivalents is relevant to this proceeding and the ordinary American purchasers of wine would understand that NIGHT is the English equivalent of the registered mark, NOCHE, and vice-versa. The term, whether in English or Spanish, has no demonstrated meaning in the context of wine and will likely be understood as an arbitrary use of the word. Thus, the significance to the wine consumer of the terms NIGHT and NOCHE will likely be the same.

The *Tia Maria* decision, which Applicant cites in support of its argument that the doctrine of foreign equivalents should not apply in this case, involved an applicant offering restaurant services under the mark TIA MARIA versus a registrant's use of AUNT MARY'S on canned fruit and vegetable products. The Board clearly took into consideration the context in which consumers would encounter the respective marks in connection with the involved goods and services when deciding whether consumers would perceive the marks as equivalents:

But, nevertheless there are foreign expressions that even those familiar with the language will not translate, accepting the term as it is, and situations arise in the marketplace which make it unfeasible or even unlikely that purchasers will translate the brand names or labels appearing on canned foods and other like products. ... That is, insofar as this reasoning applies to the instant case, it is unlikely to expect that a person encountering "AUNT MARY'S" canned fruits and vegetables in a supermarket or other establishment where goods of this type are customarily sold would translate "AUNT MARY'S" into "TIA MARIA", and then go one step further and associate these food products with applicant's restaurant. Likewise, going the other route, it is difficult to perceive that a person who had purchased "AUNT MARY'S" canned fruits and vegetables on the shelves of a supermarket would, upon dining at the "TIA MARIA" restaurant in Mexican decor and surrounded by a menu of Mexican delicacies, translate "TIA MARIA" into "AUNT MARY" and then mistakenly assume that the "TIA MARIA" restaurant and "AUNT MARY'S" canned fruits and vegetables originate from or are sponsored by the same entity.

In re Tia Maria, Inc., 188 USPQ at 526.

In contrast, in this case we must consider the fact that consumers will be encountering the involved marks on the same goods, i.e., wine. As discussed above, we must also presume that the same consumers will be encountering these marks on wine in the same, usual trade channels for wine, including wine stores and restaurants. Thus, unlike *Tia Maria*, the environment in which the marks are

encountered is the same and we do not find it “difficult to perceive” that a consumer would stop and translate the two marks upon encountering them on wine.

Under the circumstances, we find that the similarity between the marks based on them having the same meaning outweighs the differences based on sound and appearance, and the *du Pont* factor of the similarity or dissimilarity of the marks weighs in favor of a finding of likelihood of confusion. *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983) (“the PTO may reject an application ex parte solely because of similarity in meaning of the mark sought to be registered with a previously registered mark”); see also, *Bost Bakery, Inc. v. Roland Industries, Inc.*, 216 USPQ 799, 801 (TTAB 1991) (“the principle that similarity between marks in meaning or commercial significance alone may be sufficient to create a likelihood of confusion is applicable primarily to situations where marks are coined or arbitrary rather than highly suggestive”).

3. Other Factors Argued

Applicant argues that “use of the term MIDNIGHT on wine by third parties demonstrates the number and nature of similar marks in the marketplace and indicates that consumers will not be confused by applicant’s use of the mark NIGHT.”¹⁷ However, there is no evidence of record showing third parties using the term MIDNIGHT or any other similar term in marks in commerce on wine. As discussed supra, the list of COLAs is not evidence of third-party use of any marks in commerce. In any event, the marks at issue here are NIGHT and NOCHE. Although

¹⁷ 7 TTABVUE 14.

not entirely unrelated, MIDNIGHT has a different meaning than the marks before us. Even if we were able to conclude that MIDNIGHT is commercially weak as a trademark for wine, Applicant has not explained why that would compel a finding that either NIGHT or NOCHE likewise is weak.

Applicant also argues that the “sophistication of wine drinkers tends to weigh against a finding of likelihood of confusion.”¹⁸ However, there is no evidence to suggest this is the case. Moreover, Applicant’s and Registrant’s goods are simply identified as “wine,” and we must construe this as including wine being sold at all price points, including the least expensive wine, and to all usual purchasers of wine. We must base our decision “on the least sophisticated potential purchasers.” *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014) (quoting *Gen. Mills, Inc. v. Fage Dairy Proc. Indus. S.A.*, 100 USPQ2d 1584, 1600 (TTAB 2011), *judgment set aside on other grounds*, 2014 WL 343267 (TTAB Jan. 22, 2014)).

Accordingly, the aforementioned two factors remain neutral in our analysis.

4. Conclusion

Considering all the evidence of record, we find that there is a likelihood of confusion. We come to this conclusion based on our findings that the marks are somewhat similar in structure and identical in connotation and will be used on identical goods, namely wine, which we must presume will be encountered by the same consumers in common channels of trade.

¹⁸ 7 TTABVUE 13.

Decision: The refusal to register Applicant's mark on the ground of likelihood of confusion is affirmed.